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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,401	07/31/2003	Keiji Hashimoto	15468-004001 / PA0117US	2928
20985	7590	08/29/2006		EXAMINER
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ALEJANDRO, RAYMOND	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/632,401	HASHIMOTO ET AL.
	<b>Examiner</b> Raymond Alejandro	<b>Art Unit</b> 1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 August 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3-15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) 3-15 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

In response to applicant's amendment dated 08/11/06, please note the following action: only the 35 USC 112 rejections have been overcome. Refer to the abovementioned amendment for specific details on applicant's rebuttal arguments. However, the present claims are finally rejected over the same art as set forth hereinbelow and for the reasons of record:

### ***Election/Restrictions***

1. Claims 3-15 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 04/20/06, 04/05/06 and 03/09/06.

### ***Specification***

2. The title of the invention is still not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

3. Claims 3-15 (non-elected) are objected to because of the following informalities: status identifiers in claims 3-15 are incorrect. They should read "(withdrawn)" instead of either "(original)" or "(currently amended)". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the European publication EP 1098380 (hereinafter referred to as the EP'380).

The present claims are directed to a separator wherein the disclosed inventive concept comprises the specific separator comprising materials which are made different.

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As to claim 1:

The EP'380 reveals a gas separator for fuel cells obtained as a laminate of unit cells (ABSTRACT). Disclosed is that gas separator 30 has a base plate unit 60 that is obtained by bonding two base plates 62 and 64 molded to have predetermined shapes (ABSTRACT). The separator is combined with adjoining members to define either a flow path of a gaseous fuel or a flow path of an oxidizing gas, and separates a flow of gaseous fuel from a flow of oxidizing gas (P.0001, 0003). *Thus, the separator of the EP'380 faces the fuel cell anode at one side and the fuel cell cathode at the other side.*

(*emphasis supplied* →) The EP'380 reveals that base plates 62 and 64 are made of a metal material such as stainless steel or aluminum (P0064,0010, 0019, 0031,0051,0056). Note that stainless is an alloy of steel with chromium and sometimes another element such as Ni or Mo (Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> Edition). Therefore, base plates of the EP'380 are made of a chromium-containing alloy (chrome alloy) and nickel-containing alloy. As a result, the characteristic of reducing elution of metal ions is inherent due to the chromium-containing alloy (chrome alloy); and the characteristic of being difficult to form a thick oxide coating layer is also inherent due to nickel-containing alloy.

1<sup>st</sup> Examiner's note: applicant discloses that "the chrome alloy has reduced elution of metal ion" and "the nickel alloy has a characteristic of being difficult to form a thick oxide coating layer" (See applicant's specification at page 14, lines 15-26 and the 08/11/06 amendment at page 8, last full paragraph). That being said, it is contended that since stainless steel is an alloy containing multiple components such as steel, chromium, nickel and molybdenum, it is an alloy composed of chromium as well as nickel, therefore the claimed

*characteristics are inherent to the alloy material. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102/103.*

*The burden of proof is on applicant In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).*

*See MPEP 2112.*

As to claim 2:

Disclosed is that the gas separator 30 has a base plate unit 60 that is obtained by bonding two base plates 62 and 64 molded to have predetermined shapes (ABSTRACT).

2<sup>nd</sup> Examiner's note: it is noted that the instant claims are being construed as product-by-process claims (i.e. the limitation reciting "the bonding" of the separator members) and that the product itself does not depend on the process of making it. Accordingly, in a product-by-process claim, the patentability of a product does not depend on its method of production. In that, it is further noted that the product in the instant claims is the same as or obvious over the product of the prior art.

Therefore, claim 2 is anticipated by the EP'380. However, if the claims are not anticipated the claims are obvious as it has been held similar products claimed in product-by-process limitations are obvious In re Brown 173 USPQ 685 and In re Fessman 180 USPQ 324 (Refer to MPEP 2113: Product-by-Process Claims).

***Response to Arguments***

8. Applicant's arguments filed 08/11/06 have been thoroughly considered but they are not persuasive.

9. The principal argument raised by the applicant is based apparently on the assertion that because "*both half members (of the separator Yoshimura et al) are made of the same material (stainless steel)*" they are incapable of exhibiting "*the characteristics of reducing elution of metal ions and of being difficult to form a thick oxide coating layer*". The examiner disagrees with applicant's position; and shifts the burden to applicant to prove otherwise based on the 102/103 inherency ground of rejection as set forth above.

Concerning this matter, the EP'380 reveals that base plates 62 and 64 are made of a metal material such as stainless steel or aluminum (P0064,0010, 0019, 0031,0051,0056). Note that stainless is an alloy of steel with chromium and sometimes another element such as Ni or Mo (*Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> Edition*). Therefore, base plates of the EP'380 are made of a chromium-containing alloy (chrome alloy) and nickel-containing alloy. As a result, the characteristic of reducing elution of metal ions is inherent due to the chromium-containing alloy (chrome alloy); and the characteristic of being difficult to form a thick oxide coating layer is also inherent due to nickel-containing alloy.

Applicant discloses that "the chrome alloy has reduced elution of metal ion" and "the nickel alloy has a characteristic of being difficult to form a thick oxide coating layer" (*See applicant's specification at page 14, lines 15-26 and the 08/11/06 amendment at page 8, last full paragraph*). That being said, it is contended that since stainless steel is an alloy containing multiple components such as steel, chromium, nickel and molybdenum, it is an alloy composed

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of chromium as well as nickel, therefore the claimed characteristics are inherent to the alloy material. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102/103. The burden of proof is on applicant *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (*quoting In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)). See MPEP 2112.

10. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. This is in response to applicant's arguments that "*there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed*".

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Alejandro whose telephone number is (571) 272-1282. The examiner can normally be reached on Monday-Thursday (8:00 am - 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond Alejandro  
Primary Examiner  
Art Unit 1745



RAYMOND ALEJANDRO  
PRIMARY EXAMINER